UNITED STATES PATENT AND TRADEMARK OFFICE

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PAULA, CESAR B

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 July 2005*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-16 and 34-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-16 and 34-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.　　　This action is responsive to the RCE filed on 7/21/2005.

This action is made Non-Final.

2.　　　In the amendment, claims 17, 20-33 have been canceled. Claims 1, 3-16, and 34-39 are pending in the case. Claims 1, 8, 12, 34, 37, and 39 are independent claims.

3.　　　The rejections of claims 1, 3-16 rejected under 35 U.S.C. 102(b) as being anticipated by Judson (Pat.# 5,572,643, 11/5/1996), have been withdrawn as necessitated by the amendment.

Priority

4.　　　Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on application # 2000-371676 filed in Japan on 12/6/2000, which papers have been placed of record in the file.

Drawings

5.　　　The drawings filed on 12/6/2001 have been approved by the examiner.

Claim Objections

6.　　　The objection to claim 25 has been withdrawn as necessitated by its cancellation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis

for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 34-39 remain rejected under 35 U.S.C. 102(b) as being anticipated by Judson

(Pat.# 5,572,643, 11/5/1996).

Regarding independent claim 34, Judson teaches a browser for receiving, and storing

information in a RAM connected in a computer with a cpu, which also executes downloaded

applets for displaying advertisement informational objects. A user selects links, and causes the

downloading of web pages according to various criteria, such as using a particular URL,

bookmarks, etc, and Applets associated with the web pages. Applets associated with web pages

are downloaded for displaying advertisements related to the respective downloaded web pages

(col.4, lines 10-24, col.6, lines 6-16, col.7, lines 1-7, fig.2). In other words, a user clicks on a

link, downloads a web page along with associated applet, and advertisement information. Then,

the user wants to retrieve another web page using a bookmark. The new web page is downloaded

along with a new applet, and advertisement information *–an information receiving unit for*

receiving updates to said executable program data and advertisement data from an external

source and updating the executable program data and advertisement data based on said updates.

Furthermore, Judson teaches the generation, and display of an output information, such as

an advertisement, as a result of executing the applet, such as the applet of a newly downloaded

web page. The applet is stored and later reused when a related link is established-- *presenting an*

advertisement based on advertisement data and, after presenting the advertisement, requiring an

input from a user before allowing the processor to execute program data (col.6, lines 6-16, col.7,

lines 1-14, fig.2).

Regarding claim 35, which depends on claim 34, Judson discloses a browser, which

receives, and stores in RAM, executable applets, and advertisement information presented by the

applets-- *a storage medium mounting unit an information storage medium storing executable*

program data and advertisement data mounted on the storing medium mounting unit (col.4, lines

10-24, col.6, lines 6-16, col.7, lines 1-7, fig.2).

Furthermore, Judson teaches the browser-- *storage medium reading unit operably*

connected to the processor reading executable program data and advertisement data from said

storage medium-- generating, and displaying the output information in RAM, such as an

advertisement, as a result of executing the applet, such as the applet of a newly downloaded web

page. (col.6, lines 6-16, col.7, lines 1-14, fig.2).

Regarding claim 36, which depends on claim 35, Judson teaches a user using a browser--

communications unit communicating to the external source a request for an update to the

executable program data and receiving the update to the executable program data and new

advertising data-- selects links, and causes the downloading of web pages according to various

criteria, such as using a particular URL, bookmarks, etc, and Applets associated with the web

pages. Applets associated with web pages are downloaded for displaying advertisements related

to the respective downloaded web pages (col.6, lines 1-16, col.7, lines 3-21, fig.2).

Regarding independent claim 37, Judson discloses a browser for receiving, and storing

information in a RAM connected in a computer, which also executes downloaded applets for

displaying advertisement informational objects -- *an information storage medium storing*

executable program data and advertisement data operably connected to said processor (col.4,

lines 10-24, col.6, lines 1-16, col.7, lines 1-7, fig.2).

Moreover, Judson teaches a user selects links, and causes the downloading of web pages

according to various criteria, such as using a particular URL, bookmarks, etc, and Applets

associated with the web pages. Applets associated with web pages are downloaded for displaying

advertisements related to the respective downloaded web pages (col.6, lines 1-16, col.7, lines 3-

21, fig.2). In other words, a user clicks on a link, downloads a web page along with associated

applet, and advertisement information. Then, the user wants to retrieve another web page using a

bookmark. The new web page is downloaded along with a new applet, and advertisement

information *–an information receiving unit for receiving updates to said executable program*

data and advertisement data from an external source and updating the executable program data

and advertisement data based on said updates.

Furthermore, Judson teaches the generation, and display of an output information, such as

an advertisement, as a result of executing the applet, such as the applet of a newly downloaded

web page. The applet is stored and later reused when a related link is established-- *for presenting*

an advertisement based on advertisement data and, after presenting the advertisement, requiring

an input from a user before allowing the processor to execute program data (col.6, lines 1-16,

col.7, lines 1-14, fig.2).

Regarding claim 38, which depends on claim 37,Judson discloses a browser for

receiving, and storing information in a RAM connected in a computer, which also executes

downloaded applets for displaying advertisement informational objects (col.4, lines 10-24, col.7,

lines 6-16, col.7, lines 1-7, fig.2).

Regarding independent claim 39, Judson discloses a cpu connected to a graphic display

(col.4, lines 7-35, fig.2).

Moreover, Judson discloses a browser for receiving, and storing information in a RAM

connected in a computer to the cpu, which also executes downloaded applets for displaying

advertisement informational objects -- *providing an information storage medium storing*

executable program data and advertising data; operably connecting the information storage

medium storing executable program data and advertisement data to the processor; when a

request to execute the executable program is received by the processor, displaying an

advertisement based on the advertisement data (col.4, lines 10-24, col.6, lines 1-16, col.7, lines

1-7, fig.2).

Moreover, Judson teaches the generation, and display of an output information, such as

an advertisement, as a result of executing the applet, such as the applet of a newly downloaded

web page. The applet is stored and later reused when a related link is established-- *requiring a*

user input after displaying the advertisement before executing the executable program; when the user input is received, executing the executable program; (col.6, lines 6-16, col.7, lines 1-14, fig.2).

Furthermore, Judson teaches a user selects links, and causes the downloading of web pages according to various criteria, such as using a particular URL, bookmarks, etc, and Applets associated with the web pages. Applets associated with web pages are downloaded for displaying advertisements related to the respective downloaded web pages (col.7, lines 1-16, col.7, lines 3-21, fig.2). In other words, a user clicks on a link, downloads a web page along with associated applet, and advertisement information. Then, the user wants to retrieve another web page using a bookmark. The new web page is downloaded along with a new applet *requesting an update to the executable program from an external source,* and advertisement information--*receiving an update to the executable program and updated advertising data; updating the executable program and the information storage medium with the advertising information on received update.*

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 1, 3-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Judson.

(Pat.# 5,572,643, 11/5/1996), in view of Simpson, A., "Mastering WordPerfect 5.1 & 5.2 For

Windows", hereinafter Wordperfect, Sybex, 1993, pages 21-22, 403-407.

Regarding independent claim 1, Judson discloses a client retrieving a web page having an

embedded or masked object, such as an advertisement, stored within the web page–*receiving*

desired information together with advertisement supplied from the outside -- (col.2, lines 1-11,

35-45, 54-67, col.4, lines 1-35, and col.5, lines 40-col.6, line 12).

Moreover, Judson discloses retrieving, and displaying the embedded or masked object,

such as an advertisement, as a result of activating a link on the web page –*executing a prescribed*

process on said desired information, presenting when said prescribed process is executed by said

processing means an advertisement based on said advertisement data received by said

information receiving unit-- (col.2, lines 1-11, 35-45, 54-col. 3, line 2, and col.5, lines 40-col.6,

line 11, col.8, lines 1-17).

Moreover, Judson discloses downloading a web page storing an embedded or masked

object, such as an advertisement, stored within the client's RAM chip (implying detachment, or

cache memory—*detachably mounted*), and then displaying the advertisement on the browser –*a*

storage mounting unit to which an information storage medium storing in advance said desired

information and said advertisement data -- (col.2, lines 1-11, 35-45, 54-67, and col.4, lines 1-35,

fig.2).

Furthermore, Judson discloses displaying the embedded or masked object from RAM,

such as an advertisement, as a result of activating a link on the web page –*reading said desired*

information together with the advertisement data related to the desired information -- (col.2,

lines 1-11, 35-45, 54-col. 3, line 2, and col.5, lines 40-col.6, line 11, col.8, lines 1-17). Judson

fails to explicitly disclose: *a nonvolatile information storage medium storing in advance said*

desired information and said advertisement data. Wordperfect discloses allowing a user to save

a document a nonvolatile medium, such as a floppy disk (drive a) or hard drive—drive c (pages

22, 404-406). However, it would have been obvious to a person of ordinary skill in the art at the

time of the invention to combine Judson, and Wordperfect, because Judson teaches above

displaying advertisements based on the type of access history of a user. This would provide the

benefit of providing a variety of updated advertisement which more effectively resembles the

tastes of a wide range of clients, in accordance with the latest products available from the

advertiser, and which allows the flexibility of accessing a webpage offline, at user's leisure.

Regarding claim 3, which depends on claim 1, Judson discloses a browser downloading a

web page storing an embedded or masked object within HTML tags *–additional data*

corresponding to a HTML *type to be added as an object* after the user selects the link --, such as

an advertisement, stored within the client having a hard disk (col.2, lines 1-11, 35-45, 54-67, and

col.4, lines 1-35).

Regarding claim 4, which depends on claim 1, Judson discloses the client using a

browser for downloading the web page storing the advertisement, using a modem for

communicating with other computers over a network *–communication unit for communicating*

with the outside through a communication path, and receiving through said communication unit,

desired information together with advertisement -- (col.2, lines 1-11, 35-45, 54-67, and col.4,

lines 1-4, 30-35).

Regarding claim 5, which depends on claim 4, Judson discloses a browser for

downloading a web page from a server by selecting a link *–specifying* HTML *type of said*

additional data, based on execution result of said prescribed process by said processing means,

and receiving from the outside..said additional data -- (col.1, lines 27-33, col.2, lines 1-11, 35-

45, 54-67, col.4, lines 30-35). The downloading is performed using a modem for communicating

with other computers over a network for retrieving the web page.

Regarding claim 6, which depends on claim 5, Judson discloses a browser for selecting

advertisements based on the user's web page access history—*advertisement specifying data for*

specifying said advertisement data (col.7, lines 10-17). In this case, the browser receives the

access history—*advertisement data included in said acquisition request transmitted by said*

additional data requesting means.

Regarding claim 7, which depends on claim 1, Judson discloses clients for downloading a

web page, which stores the advertisement. The clients are personal computers (col.1, lines 27-33,

col.2, lines 1-11, 35-45, 54-67, col.3, lines 47-67). Personal computer can be carried from one

location to the next—*portable apparatus.*

Regarding independent claim 8, Judson discloses a client using a modem for downloading or receiving a web page having, a link, and a embedded or masked object, such as an advertisement, over a network –*receiving desired information for executing a prescribed process, and advertisement data related to the desired information* -- (col.1, lines 27-33, col.2, lines 1-11, 35-45, 54-67, col.4, lines 1-35, and col.5, lines 40-67).

Moreover, Judson discloses storing of the retrieved web page along with the embedded objects, in memory, such as a RAM chip, cache or hard drive, installed in the client's computer –*executing a prescribed process on said desired information, presenting when said prescribed process is executed by said processing means an advertisement based on said advertisement data received by said information receiving unit*-- (col.2, lines 1-11, 35-45, 54-67, col. 4, lines 1-35, and col.5, lines 40-col.6, line 11, fig.2). Judson fails to explicitly disclose: *a nonvolatile storage medium detachably mounted.* Wordperfect discloses allowing a user to save a document a nonvolatile medium, such as a floppy disk (drive a) or hard drive—drive c (pages 22, 404-406). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Judson, and Wordperfect, because Judson teaches above displaying advertisements based on the type of access history of a user. This would provide the benefit of providing a variety of updated advertisement which more effectively resembles the tastes of a wide range of clients, in accordance with the latest products available from the advertiser, and which allows the flexibility of accessing a webpage offline, at user's leisure.

Regarding claim 9, which depends on claim 8, Judson discloses a client using a modem for downloading or receiving a web page having an embedded or masked object, such as an

advertisement, over a network into RAM, cache or hard drive –*stores in advance information specifying data for specifying said desired information and advertisement specifying data --* (col.1, lines 27-33, col.2, lines 1-11, 35-45, 54-67, col.4, lines 1-35, and col.5, lines 40-67).

Moreover, Judson discloses the downloading of a web page, and retrieval and display of a related advertisement embedded object as a result of selecting and activating the link –*executing a prescribed process on said desired information, presenting when said prescribed process is executed by said processing means an advertisement based on said advertisement data received by said information receiving unit--* (col.2, lines 1-11, 35-45, 54-67, col. 4, lines 1-35, and col.5, lines 40-col.6, line 11, fig.2). Judson fails to explicitly disclose: *a nonvolatile storage medium stores in advance information specifying said desired information.* Wordperfect discloses allowing a user to save a document a nonvolatile medium, such as a floppy disk (drive a) or hard drive—drive c (pages 22, 404-406). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Judson, and Wordperfect, because Judson teaches above displaying advertisements based on the type of access history of a user. This would provide the benefit of providing a variety of updated advertisement which more effectively resembles the tastes of a wide range of clients, in accordance with the latest products available from the advertiser, and which allows the flexibility of accessing a webpage offline, at user's leisure.

Regarding claim 10, which depends on claim 8, Judson discloses a link stored in the web page to enable a client to download of a web page, retrieve and display of a related advertisement embedded object as a result of selecting and activating the link –*stores in advance connection*

destination data and said communication unit communicates with said external information

supplying unit based on said connection-- (col.2, lines 1-11, 35-45, 54-67, col. 4, lines 1-35, and

col.5, lines 40-col.6, line 11, fig.2). Judson fails to explicitly disclose: *said nonvolatile storage*

medium stores in advance connection destination data specifying said desired information.

Wordperfect discloses allowing a user to save a document a nonvolatile medium, such as a

floppy disk (drive a) or hard drive—drive c (pages 22, 404-406). However, it would have been

obvious to a person of ordinary skill in the art at the time of the invention to combine Judson,

and Wordperfect, because Judson teaches above displaying advertisements based on the type of

access history of a user. This would provide the benefit of providing a variety of updated

advertisement which more effectively resembles the tastes of a wide range of clients, in

accordance with the latest products available from the advertiser, and which allows the flexibility

of accessing a webpage offline, at user's leisure.

Regarding claim 11, which depends on claim 8, Judson discloses a client for

downloading of a web page, retrieve and display of a related advertisement embedded object as a

result of selecting and activating the link (col.2, lines 1-11, 35-45, 54-67, col. 4, lines 1-35, and

col.5, lines 40-col.6, line 11, fig.2). In other words, the web page is displayed in addition to the

advertisement at the client.

Regarding independent claim 12, Judson discloses downloading a web page storing an

embedded or masked object, such as an advertisement, stored within the client's RAM chip–

receiving desired information together with advertisement -- (col.2, lines 1-11, 35-45, 54-67, and

col.4, lines 1-35).

Moreover, Judson discloses displaying the embedded or masked object, such as an

advertisement, as a result of activating a link on the web page *–reading said desired information*

receiving unit-- (col.2, lines 1-11, 35-45, 54-col. 3, line 2, and col.5, lines 40-col.6, line 11).

Moreover, Judson discloses retrieving, and displaying the embedded or masked object,

such as an advertisement, as a result of activating a link on the web page *–processing means for*

executing a prescribed process on said desired information, presenting said advertisement data

read by said storage medium reading unit, when a request to execute said prescribed process is

received by said processing means (col.2, lines 1-11, 35-45, 54-col. 3, line 2, and col.5, lines 40-

col.6, line 11).

Furthermore, Judson discloses that the web page has embedded or masked objects, such

as an advertisement, attached to links stored within *–receiving desired information together with*

advertisement – the RAM memory (col.2, lines 1-11, 35-45, 54-67, col.4, lines 1-35, and col.5,

lines 40-67). In other words, the links enable the presentation of the advertisements, so after the

user clicks on a first link, a first advertisement is presented. A second advertisement is presented,

when a second link is clicked on (after the first link is clicked on)-- *and allowing said processing*

means to execute the prescribed process after presenting said advertisement data and receiving

an input from a user. Judson fails to explicitly disclose: *a nonvolatile storage medium storing*

desired information and advertisement data related to the desired information. Wordperfect

discloses allowing a user to save a document a nonvolatile medium, such as a floppy disk (drive

a) or hard drive—drive c (pages 22, 404-406). However, it would have been obvious to a

person of ordinary skill in the art at the time of the invention to combine Judson, and

Wordperfect, because Judson teaches above displaying advertisements based on the type of

access history of a user. This would provide the benefit of providing a variety of updated

advertisement which more effectively resembles the tastes of a wide range of clients, in

accordance with the latest products available from the advertiser, and which allows the flexibility

of accessing a webpage offline, at user's leisure.

Claims 13-16 are directed towards an information processing terminal for implementing

the apparatus found in claims 2-3, 5, and 7 respectively, and therefore are similarly rejected.

Response to Arguments

10.   Applicant's arguments filed 7/21/2005 have been fully considered but they are moot in

light of the newly found prior art. Regarding claims 1-7, the Applicant indicates that the claims

are allowable over Judson in view of the amendment of the nonvolatile memory (page 13).

The Applicants are directed towards the rejection of the newly added limitation above.

11.   Applicant's arguments filed 7/21/2005 have been fully considered but they are not

persuasive. Regarding claims 34, 37, and 39, the Applicants submit that Judson has no teaching

that Judson does not disclose executable data (pages 13-15). The Examiner disagrees, because

Judson teaches a browser for receiving, and storing information in a RAM connected in a

computer with a cpu, which also executes downloaded applets for displaying advertisement

informational objects. A user selects links, and causes the downloading of web pages according

to various criteria, such as using a particular URL, bookmarks, etc, and Applets associated with

the web pages. Applets associated with web pages are downloaded for displaying advertisements

related to the respective downloaded web pages (col.4, lines 10-24, col.6, lines 6-16, col.7, lines

1-7, fig.2). In other words, a user clicks on a link, downloads a web page along with associated

applet-- *executable program data*, and advertisement information. Then, the user wants to

retrieve another web page using a bookmark. The new web page is downloaded along with a new

applet, and advertisement information *–an information receiving unit for receiving updates to*

said executable program data and advertisement data from an external source and updating the

executable program data and advertisement data based on said updates.

Conclusion

I.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner

can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please

allow at least one business day.

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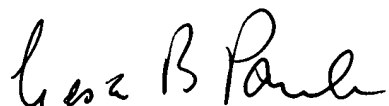system, go to http://portal.uspto.gov/external/portal/pair. Should you have any questions about

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- **(571)-273-8300** (for **all** Formal communications intended for entry)

CESAR PAULA
PRIMARY EXAMINER
10/17/05